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direction transverse to the operative disposition of the second member longitudinal axis and with a selected spacing in relation to the characteristic arrangement of the second member to adaptively permit freedom of movement between the guide and the second member during the displacement between the members along the operative disposition of the second member longitudinal axis.

Remarks

This Amendment is provided in response to the Office Action (Paper No. 5) mailed December 16, 2002, which rejected claims 1-25 and allowed claims 26-36. In response, the Applicants have cancelled some claims and amended the claims to obviate the rejections. These amendments do not introduce new matter and will not provide an undue burden upon the Examiner.

The status of the pending claims is now as follows:

<u>Claim</u>	<u>Status</u>
2. (Amended)	Independent.
4. (Original)	Depends from claim 2.
5. (Original)	Depends from claim 2.
6. (Original)	Depends from claim 5.
7. (Original)	Depends from claim 2.
11. (Original)	Depends from claim 2.
12. (Amended)	Depends from claim 2.
13. (Amended)	Depends from claim 5.
14. (Original)	Depends from claim 13.
15. (Original)	Depends from claim 13.
16. (Amended)	Independent.
18. (Original)	Depends from claim 16.
19. (Original)	Depends from claim 18.
20. (Amended)	Depends from claim 16.
22. (Original)	Depends from claim 16.
23. (Original)	Depends from claim 16.
24. (Original)	Depends from claim 16.

25. (Amended)	Depends from claim 16.
26. (Original)	Independent.
27. (Amended)	Depends from claim 26.
28. (Original)	Depends from claim 26.
29. (Original)	Depends from claim 26.
30. (Original)	Depends from claim 26.
31. (Original)	Independent.
32. (Amended)	Depends from claim 31.
33. (Original)	Depends from claim 31.
34. (Original)	Depends from claim 31.
35. (Original)	Independent.
36. (Original)	Independent.
37. (Amended)	Independent.

Information Disclosure Statement filed October 16, 2001

The Applicants filed an information disclosure statement at the time of filing the patent application. Pursuant to the provisions of MPEP 609, it is requested that the Examiner return a copy of the Form PTO/SB/08A, marked as being considered by the Examiner.

Rejection of Claims 1-12, 16-25, and 37 Under 35 U.S.C. 102(b)

These claims were rejected as being anticipated by U.S. Patent no. 5,519,976 issued to Gee ("Gee '976").

Cancelled Claims

Claims 1, 3, 8-10, 17, and 21 have been cancelled. Withdrawal of the present rejection of these claims is respectfully requested.

Claim 2

In the rejection of claim 2, the Examiner did not consider the relationships of the clip to the first and second members because the first and second members are not positively recited in the claim language. The Applicants respectfully traverse this

rejection because a proper construction of the language of amended claim 2 renders the claim patentably distinct over Gee '976.

Gee '976 discloses a clip that is bendable to attach it to a characteristically unitary angled moulding 11. In Gee '976 a rear tab 3 "is intended to be bent at right angles." (Gee '976, col. 3 lines 4-5) The clip is constructed of materials enabling the bending to be done easily without special tools. (Gee '976, col. 3 lines 5-9). The rear tab 3 is then positionable on the vertical flange 12 of the moulding 11, and the side tabs 7, 8 are foldable over the horizontal flange 13 of the moulding 11 to attach the clip to the moulding 11. The attached clip can be slidably positioned along the moulding 11.

Generally, the preamble is not given the effect of a limitation unless it breathes life and meaning into the claim. In an apparatus claim, any language in the preamble that limits the structure of the apparatus must be given weight. Where the preamble language is directed to an intended use of the apparatus, the stated intended use must result in a structural difference between the claimed invention and the cited reference in order to patentably distinguish the claimed invention from the cited reference. However, if the cited reference structure is capable of performing the intended use, then it meets the claim. (MPEP 2111.02)

Where functional limitations are recited between a positively claimed element and an intended use limitation from the preamble, the functional limitation may properly be stated in terms such as "members adapted to be positioned" and "portions...being resiliently dilatable whereby said housing may be slidably positioned." (MPEP 2173.05(g))

The preamble language of amended claim 2 recites at least two intended use limitations that limit the structure of the clip apparatus. First, the clip is used for joining the members "in a slip joint for operatively permitting displacement between the joined members." Second, the direction of the displacement is limited to "along the operative disposition of the second member longitudinal axis."

Gee '976 does not disclose using a clip to join two members in a slip joint. Rather, Gee '976 discloses attaching the clip to a unitary member. However, if the structure of the clip disclosed by Gee '976 is capable of performing the claimed limitations associated with the intended use then it can sustain the present rejection.

Amended claim 2 recites the following language:

a guide depending from the base comprising opposing arms extending substantially transversely to the base second surface defining a channel that is receivingly engageable with and adaptively substantially spans the second member permitting freedom of movement between the guide and the second member in a sliding relationship during the displacement between the members along the operative disposition of the second member longitudinal axis.

(excerpt from claim 2, emphasis added)

It will be noted that the present invention as claimed in amended claim 2 requires that the channel formed by the guide substantially spans the second member. This is necessary in order to distribute forces during displacement across the entire cross-sectional area of the second member. Distributing the forces across the second member facilitates keeping the members in the transverse relationship and minimizes binding during the displacement. The Applicant points to the Detailed Description at page 9, lines 18-24 as being exemplary of proper support for the added limitation of the channel substantially spanning the second member.

Accordingly, the present invention as claimed in amended claim 2 requires the clip to permit displacement between the transversely joined members in a direction along the second member longitudinal axis. The Examiner reads the base of claim 2 onto the tab 3 of Gee '976, the guide of claim 2 onto the base 2 of Gee '976, and the arms of claim 2 onto the side tabs 7, 8 of Gee '976. Although not explicitly identified by the Examiner, it is understood the Examiner reads the channel of claim 2 onto the slots 4, 5 in Gee '976.

The Applicants see only three ways that one might attempt to use the clip of Gee '976 to join two longitudinal members in a slip joint as in the present invention as claimed in amended claim 2.

First, an attempt might be made to use the clip in accordance with the teaching of Gee '976 to place the tab 3 behind the first longitudinal member and fold the side tabs 7, 8 around the transverse second longitudinal member (as best illustrated in FIG. 3 of Gee '976). However, the required displacement in the direction of the second member longitudinal direction would either be prevented by the folded-over tabs or the tabs would unfold under the displacement force. The structure of Gee '976 is not capable of performing the intended use of the present invention as claimed in claim 2 because the joiner would not permit "*freedom of movement between the guide and the second member in a sliding relationship between the members along the operative disposition of the second member longitudinal axis.*" (excerpt from amended claim 2)

Second, an attempt might be made to attach the tab 3 to the first longitudinal member and the second longitudinal member might be receivingly engaged within either one of the slots 4, 5. It will be noted that the second member cannot pass through both slots 7, 8 without bending the clip in Gee '976 because the slots are coplanar with the side

tabs 7, 8 and the front section 6, as shown in FIGS. 1 – 3 of Gee '976. However, by passing the second member through only one of the slots 4, 5 the second member would be receivingly engaged only to the extent of the material thickness of the clip. The thickness of the Gee '976 clip must be made small in order to easily bend the portions without special tooling. (see Gee '976 col. 3, lines 5-9) Accordingly, the structure of Gee '976 is not capable of performing the intended use of the present invention as claimed in claim 2 because such joinder would not result in "*a channel that is receivingly engageable with and substantially spans the second member....*" (excerpt from amended claim 2)

Finally, an attempt might be made to attach the tab 3 to the first longitudinal member and bend the side tabs 7, 8 and/or the front section 6 in order to make the side tabs 7, 8 noncoplanar with the front section 6, forming a passage between the opposing members 7, 8 and 6. However, utilizing an easily deformable clip to create such a passage would likewise easily deform under the displacement loads imparted to the clip, rendering it incapable of providing the necessary lateral support to maintain the transverse disposition of the joined members during displacement. Lateral movement of the members in the present invention is prevented by the sandwiching support of the rigid opposing arms. (See Detailed Description, for example, page 7, lines 12-26)

Accordingly, the structure of the Gee '976 clip is not capable of performing the intended use as claimed in claim 2 because such a joinder would not provide "*operatively slidingly constraining the second member to maintain the transverse disposition of the first and second members during the displacement.*" (excerpt from amended claim 2)

Accordingly, although the first and second members are not positively claimed, the relationships of the clip to the first and second member must be given weight in construing the claim because the claimed intended use recites structural limitations not disclosed by Gee '976. Namely, the structure of the Gee '976 is not capable of performing the claimed intended use and as such does not read on amended claim 2. *

Further, the language of amended claim 2 is proper for establishing the structural and/or functional relationships with limitations recited only in the preamble; for example: "the base operably fixable to the first member" and "a channel that is receivingly engageable with and adaptively substantially spans...."

Gee '976 cannot sustain the Section 102 rejection because it does not disclose all the limitations of the present invention as claimed in claim 2. Reconsideration and withdrawal of the present rejection of claim 2 are respectfully requested.

Claim 16

In order to sustain a rejection under 35 U.S.C. 102 the cited reference must disclose all the limitations of the rejected claim. The Applicant respectfully traverses the present rejection because amended claim 16 recites limitations not disclosed by Gee '976.

For example, claim 16 recites "*bearing surfaces defining opposing sides of the channel to operatively adaptively substantially span the second member...during displacement.*" The Examiner reads the laterally disposed slots 4, 5 onto the channel of the present invention as claimed in claim 16. As discussed above, however, the single point contact (lateral metal thickness contacting engagement) of the Gee '976 clip does not meet the claim requirement of the channel comprising bearing surfaces substantially *

spanning the second member. This feature of the present invention advantageously spreads the displacement loads across the second member, preventing twisting and binding which would otherwise defeat the purpose for the slip joint arrangement. (see, for example, Detailed Description page 9, lines 18-24).

Because Gee '976 is silent regarding the clip operatively spanning the second member, it fails to disclose all the limitations of the present invention as claimed in amended claim 16 and therefore cannot sustain the Section 102 rejection.

Reconsideration and withdrawal of the present rejection are respectfully requested.

Claim 37

In order to sustain a rejection under 35 U.S.C. 102 the cited reference must disclose all the limitations of the rejected claim. The Applicant respectfully traverses the present rejection because amended claim 37 recites limitations not disclosed by Gee '976.

For example, claim 37 recites "*the arms being noncoplanar....*" The Examiner reads the side tabs 7, 8 and the front section 6 onto the arms of the present invention as claimed in claim 37. As discussed above, however, the side tabs 7, 8 and front section 6 are all coplanar in Gee '976. Accordingly, the only opposing arms adapted for slidingly engaging the second member are coplanar, such as 6 and 7 or 6 and 8. The noncoplanar arms of the present invention advantageously provides a channel that is easily receivingly engaged yet of a rigid construction for sufficient lateral strength and joint integrity. As discussed above, one skilled in the art would not be motivated to modify the teaching of Gee '976 by bending the tabs 6-8, because a bendable clip structure will not work in the present invention. *

Because Gee '976 is silent regarding the arms being noncoplanar, it fails to disclose all the limitations of the present invention as claimed in amended claim 37 and therefore cannot sustain the Section 102 rejection. Reconsideration and withdrawal of the present rejection are respectfully requested.

Claims 2, 4-7, 11, 12, 18-20, and 22-25

Claims 2, 4-7, 11, 12, 18-20, and 22-25 are dependent claims depending ultimately from one of the independent amended claims 2, 16, or 37 and providing additional limitations thereto. The independent amended claims 2, 16, and 37 are allowable for the reasons above, making the associated dependent claims allowable as well by providing additional limitations to an allowable independent claim.

Reconsideration and withdrawal of the present rejection of claims 2, 4-7, 11, 12, 18-20, and 22-25 are respectfully requested.

Rejection of Claims 13-15 Under 35 U.S.C. 103

Claims 13-15 are dependent claims depending from independent amended claim 2 and providing additional limitations thereto. Independent claim 2 is allowable for the reasons above, making the associated dependent claims allowable as well by providing additional limitations to an allowable independent claim. Reconsideration and withdrawal of the present rejection of claims 13-15 are respectfully requested.

References Cited but Not Relied On

None of the cited references teach all the limitations of the present invention as claimed in the independent claims, nor do any of the cited references teach or suggest any combination or modification of the cited references that would motivate a skilled artisan to arrive at the present invention as claimed in the independent claims. It is noted that all the cited references of record are nonanalogous art, and the present invention as claimed in all claims is patentable over all the references of record.

For example, without limitation, Wynar '117 discloses a corner construction bracket for wallboard. Wynar '117 is silent regarding the base first surface consisting of a planar surface adapted for parallel mating engagement with the first member and fixable thereto. Wynar is also silent regarding the guide being adapted for operatively slidingly constraining the second member during the displacement.

For example, without limitation, Swanquist '466 discloses a clip for attaching electrical boxes to metal studding. Swanquist '466 is silent regarding opposing arms adapted for receivingly engaging the second member during the displacement permitting freedom of movement between the guide and the second member. Swanquist '466 contrarily teaches away from such a sliding engagement by disclosing clamping legs that grippingly engage an inserted member for non-movement. The angled barbs 64 "bites into the inner surface 65 of the box side wall and opposes withdrawal of the box side wall from the clip structure." (Swanquist '466 col. 4 lines 8-10)

For example, without limitation, Quillin '893 discloses a clip for retaining adjacent panels in a planar relationship. Quillin '893 is silent regarding the base first surface consisting of a planar surface adapted for parallel mating engagement with the first member and fixable thereto.

This is intended to be a complete response to the Office Action mailed December 16, 2002. The Amendments contained herein are proper, do not add new matter, and do not place an undue burden or require additional searching by the Examiner. All rejections and objections are obviated such that the pending claims are in condition to pass to allowance. The Examiner is encouraged to contact the Applicant's representative below for any matter that might further facilitate prosecution on the merits.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mitchell K. McCarthy', is written over a horizontal line.

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Attorney for Applicant



EXPRESS MAIL RECEIPT NO.: ET002046844US
DEPOSITED ON MARCH 17, 2003

DKT. MKM1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wheeler et al.

Application No.: 09/978,477

Filed: October 16, 2001

For: DEFLECTION CLIP

) Group Art: 3635

)

) Examiner: S. Varner

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) ATTACHMENT

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RECEIVED

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GROUP 3600

Assistant Commissioner for Patents
Washington, D.C. 20231

ATTACHMENT TO AMENDMENT IN RESPONSE TO OFFICE ACTION
(PAPER NO. 5) MAILED December 16, 2002

Marked-Up Version to Show Changes

2. (Amended) A clip for [operatively connecting] joining a first longitudinal member transversely to a second longitudinal member in a slip joint for operatively permitting displacement between the joined members along the operative disposition of the second member longitudinal axis, [the second member comprising a medial web and one or more outer flanges], the clip comprising:

a base [connectable] comprising a first surface and an opposing second surface, the first surface consisting of a planar surface adapted for parallel mating engagement with the first member, the base operably fixable to the first member to maintain the parallel mating engagement relationship of the base first surface and the first member; and

a guide depending from the base adapted for operatively slidingly constraining the second member to maintain the transverse disposition of the first and second members during the displacement, comprising opposing arms extending substantially transversely to the base second surface defining a channel that is receivingly [engaging] engageable with and adaptively substantially spans the second member [web] permitting freedom of movement between the guide and the second member in a [characteristic operative] sliding relationship during the displacement between the members along the operative disposition of the second member longitudinal axis.

12. (Amended) The clip of claim 2 wherein the base is [attached] fixable to the first member by a fastener imparting an attachment force acting substantially parallel with the channel.

13. (Amended) The clip of claim 5 wherein the guide further comprises an indicia [indication] adaptively indicating a nominal position of the retainer.

16. (Amended) A clip for [operatively connecting] joining a first longitudinal member transversely to a second longitudinal member in a slip joint for operatively permitting displacement between the joined members along the operative disposition of the second member longitudinal axis, the first member comprising a

planar medial web adjacent one or more transverse flanges and the second member comprising a medial web and one or more outer flanges, the clip comprising:

a base comprising a first surface and an opposing second surface, the first surface consisting of a planar surface adapted for parallel mating engagement with the first member web, the base operably fixable to the first member web to maintain the parallel mating engagement relationship of the base first surface and the first member web [connectable to the first member]; and

a guide depending from the base providing a channel adapted for operatively slidingly constraining the second member web to maintain the transverse disposition of the first and second members during the displacement along the operative disposition of the second member longitudinal axis, the guide comprising: [opposing arms, at least one of the arms compressingly engaging the second member web in a characteristic operative sliding relationship]

a first arm extending substantially transversely from the base proximally adjacent the base second surface; and

a second arm extending from the base substantially in the same direction as the first arm and proximally adjacent the base second surface, the arms comprising bearing surfaces defining opposing sides of the channel to operatively adaptively substantially span the second member and that are selectively spaced apart in relation to the characteristic arrangement of the second member to adaptively

permit freedom of movement between the guide and the second member web during the displacement between the members along the operative disposition of the second member longitudinal axis.

20. (Amended) The clip of claim 16 wherein the first member [comprises a medial] web and [opposing outer] flanges [defining] define a cavity, wherein the base adaptively substantially laterally spans the cavity.

25. (Amended) The clip of claim 16 wherein the base is [attached] fixable to the first member by a fastener imparting an attachment force acting substantially parallel with the arms.

27. (Amended) The clip of claim 26 wherein the base has a planar first surface and an opposing second surface, and wherein the guide opposing arms comprise a first arm extending along a longitudinal axis substantially transverse to the base from a proximal end adjacent the second surface, and a second arm extending away from the base oriented substantially in the same direction as the first arm.

32. (Amended) The clip of claim 31 wherein the base has a planar first surface and an opposing second surface, and wherein the guide opposing arms comprise a first arm extending along a longitudinal axis substantially transverse to the base from a proximal end adjacent the second surface, and a second arm extending away from the base oriented substantially in the same direction as the first arm.

37. (Amended) A deflection clip for joining a first longitudinal member transversely to a second longitudinal member in a slip joint for operatively permitting displacement between the joined members along the operative disposition of the second member longitudinal axis, the first member comprising a planar medial web adjacent one or more transverse flanges and the second member comprising a medial web and one or more outer flanges, the clip comprising:

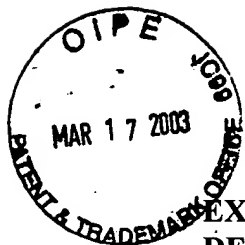
a [planar] base [plate] comprising a first surface and an opposing second surface, the first surface consisting of a planar surface adapted for parallel mating engagement with the first member web, the base operably fixable to the first member web to maintain the parallel mating engagement relationship of the base first surface and the first member web; and

a guide depending from the base [plate] operatively slidably constraining the second member web during displacement between the joined members along the operative disposition of the second member longitudinal axis, the guide comprising:

a first arm extending [along a longitudinal axis] substantially transverse to the base [plate] from a proximal end adjacent the base second surface and comprising a bearing surface adapted to slidably engage the second member during the displacement between the members; and

a second arm extending [away] from the base [plate] oriented substantially in the same direction as the first arm [defining a channel interposed laterally between the arms], the second arm comprising a bearing

surface adapted to slidingly engage the second member during the displacement between the members, the arms being noncoplanar and spaced apart in a direction transverse to the operative disposition of the second member longitudinal axis and with a selected spacing in relation to the characteristic arrangement of the second member to adaptively permit freedom of movement between the guide and the second member during the displacement between the members along the operative disposition of the second member longitudinal axis.



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DEPOSITED ON MARCH 17, 2003

DKT. MKM1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Wheeler et al.) Group Art: 3635
)
Application No.: 09/978,477) Examiner: S. Varner
)
Filed: October 16, 2001) INTERVIEW SUMMARY
)
For: DEFLECTION CLIP)
)

**Assistant Commissioner for Patents
Washington, D.C. 20231**

**SUMMARY OF TELEPHONE INTERVIEW BETWEEN APPLICANT'S
ATTORNEY AND EXAMINER VARNEY CONDUCTED MARCH 4, 2003**

Sir/Madam:

On Tuesday, March 4, 2003 at ten-o'clock EST Applicant's Attorney McCarthy was granted a telephone interview with Examiner Varner. Following is a summary of the interview in accordance with the provisions of MPEP 713.04.

McCarthy submitted proposals to independent claims 2, 16, and 37 to obviate the rejections of those claims. These proposed amendments were as follows:

2. (Amended) A clip for operatively connecting a first member to a second member in a slip joint, the second member comprising a medial web and one or more outer flanges, the clip comprising:

a base connectable to the first member; and

a guide depending from the base comprising opposing arms defining a channel
adapted to receivingly **[engaging] engage** the second member web in a
characteristic operative sliding relationship.

16. (Amended) A clip for operatively connecting a first member to a second
member in a slip joint permitting relative movement between the members, the second
member comprising a medial web and one or more outer flanges, the clip comprising:
a base connectable to the first member; and
a guide depending from the base comprising opposing arms[, **at least one of the**
arms compressingly engaging] adapted to slidingly constrain the second
member web **[in a characteristic operative sliding relationship] during the**
relative movement between the members.

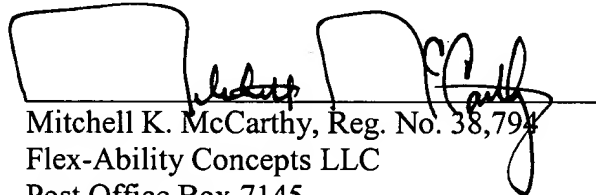
37. (Amended) A deflection clip **for joining two members to operatively**
permit relative movement between the members, the deflection clip comprising:
a planar base plate **fixable to one of the members** comprising a first surface and
an opposing second surface;
a guide depending from the base plate, comprising:
a first arm extending **in a first plane** along a longitudinal axis substantially
transverse to the base plate from a proximal end adjacent the second
surface; and
a second arm extending **in a second plane different from the first plane**
[away from the base plate oriented in the same direction as the first

arm] defining a channel [interposed laterally] between the arms adapted
to operatively constrain the other member during the movement.

No agreement was reached between McCarthy and the Examiner regarding the patentability of these proposed amended claims.

This is intended to be a complete substantive summary of the telephone interview conducted on March 4, 2003 in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'McCarthy', is written over a horizontal line. To the left of the signature is a rectangular box, and to the right is another rectangular box.

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